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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/943,776	10/03/97	DEGLI-ESTI	2000-001

HM32/1027

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EXAMINER
LAZAR WICKLEY

ART UNIT
1040

PAPER NUMBER

DATE MAILED: 10/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/943,776

Applicant(s)
Degli-Esposti

Examiner
Eliane Lazar-Wesley

Group Art Unit
1646



☒ Responsive to communication(s) filed on Dec 24, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 6-17, and 19-25 is/are pending in the application.

Of the above, claim(s) 20 and 21 is/are withdrawn from consideration.

☒ Claim(s) 2 and 22-25 is/are allowed.

☒ Claim(s) 1, 3, 6, 7, 10, 11, 13, 14, 16, and 17 is/are rejected.

☒ Claim(s) 8, 9, 12, 15, and 19 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

1. The amendment filed December 24, 1998, has been entered.

Claims 4, 5 and 18 have been canceled.

Claims 1-3, 16 and 17 have been amended, and new claims 22-25 have been added.

Claim Objections

2. Claims 8, 9, 12, 15 and 19 are objected to as dependent of canceled claims 4, 5 and 18.

Claim Rejections - 35 USC § 112

3. Claims 1, 3, 16, 17 and the dependent claims 6, 7, 10, 11, 13, 14 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 16 remain indefinite because, in c), they recite hybridization conditions, without reciting the wash conditions. Applicants argue that the Examiner's position relevant to the importance of wash conditions is improper, and Applicants request the Examiner to provide scientifically sound documentation. Maniatis et al. , Molecular Cloning, A laboratory manual, Cold Spring Harbor Laboratory, 1982, Vol. II, pages 324-325, discusses factors involved in hybridization conditions, and among them discusses the stringency of washing following hybridization, reciting that the washing conditions should be as stringent as possible, which supports the Examiner's position about the criticality of wash conditions.

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Claim 1 remains further rejected because , in d), it recites biologically active fragments of proteins, without reciting which activity . As stated in the former office action, biologically active fragments would also embrace epitopes for antibodies, that could not be used in accordance with the invention.

Claims 3 and 17 remain indefinite with respect of the percent identity for the reasons of record. While Applicants recite in the claims the use of the GAP computer program for determining identity, they do not provide in the claims or in the specification (page 9, lines 26-28), the parameters used to perform the sequence alignment, like gap penalties, mismatch penalties.

4. The claims are free of the prior art.
5. Claims 2 and 22-25 are allowable.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliane Lazar-Wesley, PhD, whose telephone number is (703) 305 4059. The examiner can normally be reached on Monday-Friday from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

Official papers filed by fax should be directed to (703) 308 4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

ELW

March 12, 1999

ELW

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER